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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,077	10/28/2003	Thomas Trieselmann	1/1408	4172

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MICHAEL P. MORRIS
BOEHRINGER INGELHEIM CORPORATION
900 RIDGEBURY ROAD
P. O. BOX 368
RIDGEFIELD, CT 06877-0368

EXAMINER	
STOCKTON, LAURA	

ART UNIT	PAPER NUMBER
1626	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/695,077	TRIESELMANN ET AL.	
	Examiner	Art Unit	
	Laura L. Stockton, Ph.D.	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) *9,10 and 13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, 11 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/24/03&12/17/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

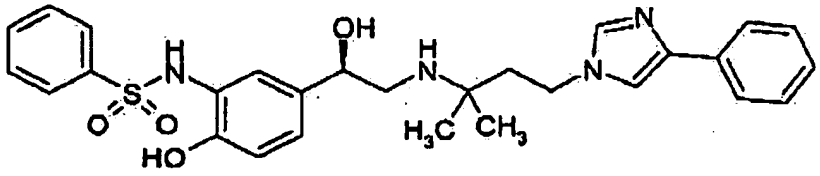
DETAILED ACTION

Claims 1-13 are pending in the application.

Election/Restrictions

Applicants' election of Group I, and the species of Example 1 found on page 31 (reproduced below), in the reply filed on August 24, 2005 is acknowledged.

Example 1



Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Subject matter not embraced by elected Group I and claims 9, 10 and 13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions. Election was made **without** traverse in the reply filed on August 24, 2005.

It is suggested that in order to advance prosecution, the non-elected subject matter be cancelled when responding to this Office Action.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The Information Disclosure Statements filed on November 24, 2003 and December 17, 2004 have been considered by the Examiner.

Claim Objections

Claims 4-8, 11 and 12 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n).

Claims 7 and 8 are objected to for being substantial duplicates of the claims from which they depend. When two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to

reject the other as being a substantial duplicate of the allowed claim. M.P.E.P. §706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, under the definition of R^3, an "and" should be added before the last compound listed. In claim 1, under the definition of R^6, "and" is misspelled. Also see claim 4 for same. In claim 1, under the definition of R^{25}-R^{28},, it is not possible to have a C_2 cycloalkyl and an "and" is needed before the

last substituent listed. In claim 5, an "and" is needed before the last structure. Claims 5 and 6 do not conform to M.P.E.P. 608.01(m) since each claim must end with a period thereby establishing that no other subject matter is missing from the claim.

Double Patenting

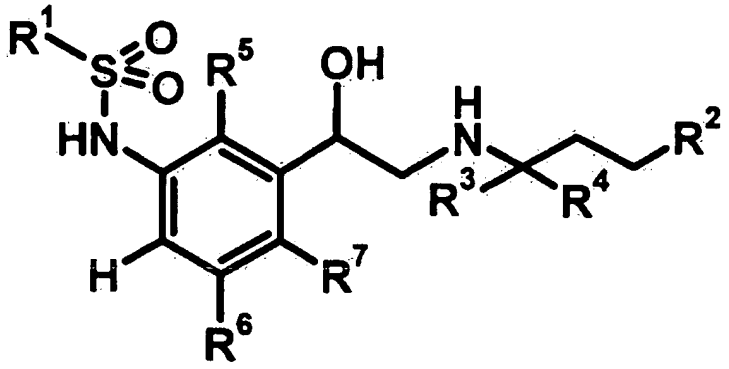
The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

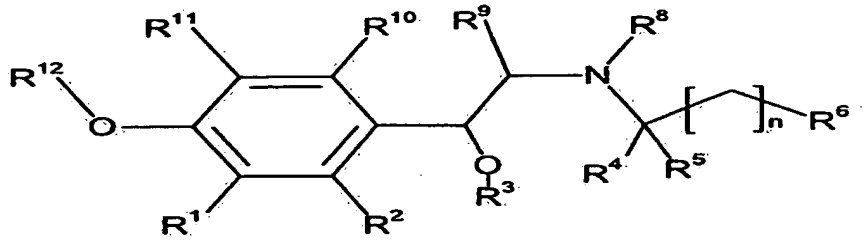
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 11 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 and 20 of copending Application No. 11/118,295. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed compounds are positional isomers of the compounds claimed in Application No. 11/118,295 {i.e., *meta*-position in Application No. 11/118,295 of the R^6 variable (represents a hydroxy or methoxy group) versus *para*-position of the O-R^{12} group (wherein R^{12} can be hydrogen or alkyl) in the instant application}.

Formula (I) in Application No. 11/118,295



formula (I) in instant application



Also compare, for example, the first compound listed in claim 16 in Application No. 11/118,295 and the instant elected species of Example 1, found on page 31 of the instant specification.

Nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer, as taught in Application No. 11/118,295, since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. *In re Norris*, 84 USPQ 458 (1950).

One skilled in the art would thus be motivated to prepare positional isomers of the products found in

Application No. 11/118,295 to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, type II diabetes. The instant claimed invention would have been suggested and therefore, obvious to one skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

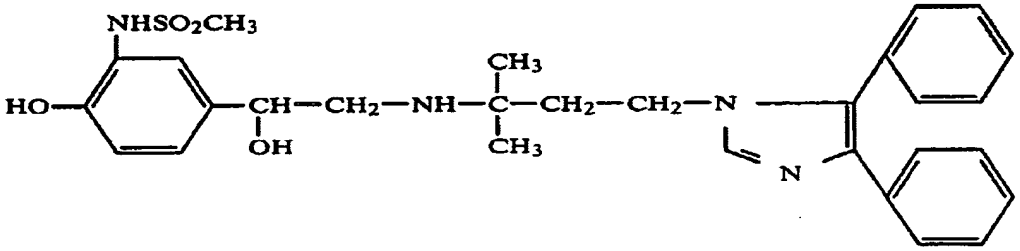
Claim Rejections - 35 USC § 102

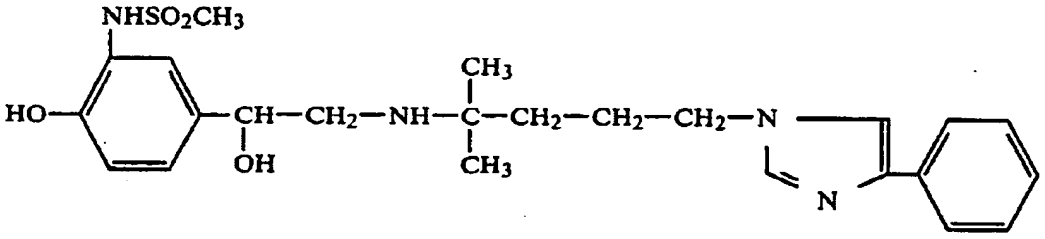
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Schromm et al. {U.S. Pat. 4,647,563}.

Schromm et al. disclose, for example, the last compound in columns 19 and 20; and the second compound in columns 21 and 22 (both reproduced below, respectively) that are embraced by the instant claimed invention. Also see column 3, lines 55-61; column 6, lines 14-21; column 31, lines 15-67; and column 33, lines 32-51.





Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schromm et al. {U.S. Pat. 4,647,563}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim imidazole compounds. Schromm et al. teach imidazole compounds that are either structurally the same as (see above 102 rejection) or structurally similar to the instant claimed compounds. See, for example, formula (I) in column 1, lines 20-68; column 2, lines 1-16; column 3, lines 55-61; column 6, lines 14-21; column 31, lines 15-67; and column 33,

lines 32-51 and especially the last compound in columns 19 and 20; and the second compound in columns 21 and 22.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., an anti-allergics).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, asthma. The instant claimed invention would have been suggested and therefore, obvious to one skilled in the art. A strong case of *prima facie* obviousness has been established.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact

the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

September 15, 2005